

Please enter the following amendments and remarks:

### **STATUS OF THE CLAIMS**

Claims 13-35 are pending in the Application.

Claims 13-35 stand rejected by the Examiner.

### **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Rejections based on 35 U.S.C. § 103(a)**

Claims 13-35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (U.S. Patent No. 4,831,526) in view of Eisenmann (U.S. Patent No. 5,459,304). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the cited references, either separately or in combination, fail to teach or suggest every limitation of the present invention as claimed. Specifically, neither Luchs nor Eisenmann, alone or in combination, teaches or suggests a system wherein the software enables automatic local printing, in response to receiving a transmitted flagged list, of at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy, from the at least one remote computer terminal, as claimed in independent claims 13 and 25.

As expressed in the present Office Action, Luchs does **NOT** teach or suggest a system for generating an insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy from a remote computer terminal, where the software uses flags to flag a list of expiring insurance policies (present Office Action, page 4). With this in mind, Luchs **CANNOT** teach or suggest software that controls or enables automatic local printing of the at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy *in response to receiving the transmitted flagged list*. In fact, Luchs describes the information (which has nothing to do with a flagged list), must actually be

reviewed or edited in order to provide a policy in the appropriate class. Thus, the information must be reviewed and/or edited before issuing, in any format, a policy (Luchs at col. 7, line 2 to col. 8, line 29), and therefore, Luchs **CANNOT** enable or control printing of a policy based on any sort of information entered at the terminal, no less in response to receiving the transmitted flagged list, because such information must first be reviewed and/or edited before issuance.

With regard to Eisenmann, there is no teaching or suggestion of a system having software that controls or enables automatic local printing of the at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy in response to receiving the transmitted flagged list. Eisenmann discloses a “smart card” and scanner system that is connected to a larger communications network. There is no printing or issuance of any insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy in the system, no less software that controls or enables local printing at a remote terminal any of these items in response to receiving the transmitted flagged list.

For the reasons as set forth above, Applicant respectfully requests reconsideration and removal of the 35 U.S.C. 103(a) rejections of independent claims 13 and 25, as neither Luchs nor Eisenmann, either separately or in combination, teach or suggest a system wherein the software enables automatic local printing, in response to receiving the transmitted flagged list, of at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy, from the at least one remote computer terminal.

Furthermore, Applicant respectfully requests reconsideration and removal of the 35 U.S.C. 103(a) rejections of claims 14-24 and 26-35, as each of these claims ultimately depends on a patentably distinguishable base claim 13 or 25.

### **CONCLUSION**

Wherefore, Applicant believes he has addressed all outstanding grounds raised by Examiner and respectfully submits that the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully Submitted,

**REED SMITH LLP**

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